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10/009,595	12/11/2001	Makoto Tabata	482842000500	4248

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EXAMINER

VERBITSKY, GAIL KAPLAN

ART UNIT PAPER NUMBER

2859

DATE MAILED: 05/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
10/009,595

Applicant(s)  
Tabata et al.

Examiner  
Gail Verbitsky

Art Unit  
2859



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Feb 6, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 3-10, 13, 14, and 19-25 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-7, 9, 10, 13, 14, 19-22, and 25 is/are rejected.
- 7) ☒ Claim(s) 4, 8, 23, and 24 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 9 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Specification*

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### *Claim Objections*

2. Claim 6 is objected to because of the following informalities: "the indicators" in line 2 because only one indicator (at least one indicator) has been positively claimed in claim 3 which claim 6 is dependent on. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1, 3, 5-7, 9-10, 13, 19-22 and 25 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 99/04230 [hereinafter Konno].

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Konno discloses in Figs. 2 and 7-9, 11 an ear thermometer comprising a main body configured to be held by an operator, a probe attached to the main body and protruding from it and configured to be inserted into an ear canal of a patient, a start measuring switch 4 located on a substantially curved second side B opposite to a first side A. If to draw a plane C (reference plane) dividing the device into two symmetrical parts, the plane C will include a center axis D of the probe and also be a center of symmetry of the curved side wherein the curved surface of the curved side will be substantially constant along the length of the plane and perpendicular to the plane C. A center F of the curved surface is in the vicinity of a base G of the probe.

It is inherent as understandable from the figures, that the operator can move his /her hand along the curved surface in order to chose (recognize) a comfortable position out of a plurality holding positions differing according to a direction in which the probe is being inserted (and the position of the patient, i.e., sitting, prone, supine, etc.). Konno states (col. 13, lines 26-28), that the switch 4 can have any shape (or any number of switches), thus, in a broad sense, suggesting the particular shape for allowing the operator to recognize a holding method (to determine the position of the hand of the operator relative to the switch) by touching the switch (the numerals A, B, C, D, F, G have been added by the Examiner, see attachment # 1 to the Office action).

For claims 3, 5-7, 9-10, 13, 22: It is inherent that a switch serve as at least one indicator relative to which the operator can move the hand and to recognize (realize) where the hand is relative to the switch (indicator). The switch (indicator/ indicator surface) is arranged in a reference plane which contains the central axis of the probe. It is inherent that, serving as an

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indicator, the switch will allow the operator to recognize the position of the main body relative to a reference (a finger placed onto the switch). It is also inherent that, dependent on the operator preference the reference can be an index finger of the operator. As shown in Figs. 9 and 11, the switch 4 constructed as a convex portion and arranged on each side relative to the reference plane.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 19-21 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Fraden (U.S. 5368038).

Fraden discloses in Fig. 1 an infrared ear type clinical thermometer comprising a main body A configured to be held by hand during temperature measurements, a probe B fixed to the main body and protruding from the main body and configured to be inserted into an external ear canal of a person whose temperature is to be measured. The main body has a first side C where the probe B protrudes from the main body, and a second opposite side D having a substantially curved surface 20 along a direction perpendicular to a reference plane E, wherein the reference plane E contains an axis of the probe B. A center of curvature G (having a substantial equal distance from any given point of the curvature) of said substantially curved surface 20 is being

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located in the vicinity of a base F of the probe B. Fraden also discloses a start switch located symmetrically with respect to the reference plane.

It is inherent that, depending on the operator's preferences, the operator can place a hand and slide it over the main body during the measurements, the way it is comfortable for the operator and provide a good grip (holding position), thus, a plurality of holding positions is available for the operator, while, no matter what the holding position is, the switch 70 is operable to switch the device on/ off. It is also inherent, that, shape of the main surface, allows the operator to move the hand along the surface of the main body, and, it is furthermore inherent that, touching the surface of the main body, the operator can recognize where of the plurality of possible holding positions allowed by the shape of the main body, he can move/ slide the hand in order to position it comfortable for the measurements, thus the inherently shape allows the operator not only to move the hand but also to recognize that the hand can be moved in a plurality of holding methods. (The numerals A-G have been added by the Examiner, see attachment # 2 to the Office Action).

### *Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

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to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Konno.

Konno discloses the device as stated above in paragraph 4.

Konno does not teach that the indicator is constructed as a concave portion.

With respect to the particular shape of the indicator, i.e., concave, the particular shape of the indicator, i.e., concave, absent any criticality, is only considered to be an obvious modification of the shape disclosed by Konno because the court has held that a change in shape or configuration, without criticality, is within the level of skill in the art as the particular shape claimed by applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide. In re Dailey, 149 USPQ 47 (CCPA 1976).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device disclosed by Konno, so as to make the shape of the indicator/ switch, concave, so as to allow the operator to have a better tactile information in order to properly position his finger onto the switch without looking at it during measurements.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

***Allowable Subject Matter***

10. Claims 4, 8, 23-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

11. Applicant's arguments with respect to claims 1, 3-10, 13-14, 19-21, 25 have been considered but are moot in view of the new ground(s) of rejection.

Applicant states that the Examiner refers to a center of symmetry and not to a center of curvature, and that the center of symmetry is not necessarily the same that the center of the curvature. This argument is not persuasive, because A) the Examiner, in fact, refers to the center F of the curved surface, thus, center of curvature, B) The applicant claims a "substantially curved surface" which, according to a court decision, means "closely approximate" (*See in re Ecolab Inc. V. Envirochem, Inc.*, 264 F. 3d 1358, 1367, 60 USPQ2d 1173 (Fed. Cir. 2001)). Thus, what applicant calls a center of a curvature is, in fact, an approximate center of a curvature, as well as the one used by the Examiner.



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With respect to plurality of holding positions: In the rejection on the merits of the claims, the Examiner interprets holding positions as holding/ sliding the operators hand along the device relative to an indicator (switch) and the operators index finger positioned on the switch.

*Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in the PTO-892 and not mentioned above disclose related devices.

13. Any inquiry concerning this communication should be directed to the Examiner Verbitsky who can be reached at (703) 306-5473 Monday through Friday 7:30 to 4:00 ET.

Any inquiry concerning this communication should be directed to the group receptionist whose telephone number is (703) 308-0956.

GKV

April 28, 2003

Gail Verbitsky



Patent Examiner, TC 2800